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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/868,126

06/14/2001

Burkhard Reitze

M0-6389/LEA

5684

7590

10/30/2003

Bayer Corporation
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Pittsburgh, PA 15205-9741

EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,126

Applicant(s)

REITZE ET AL.

Examiner

Tae H Yoon

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 7, 9, 12, 17-24, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 9, 12, 17-24, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7, 9, 12, 17-24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adelman et al (US 4,131,575) in view of Harke et al (US 5,710,204).

Adelman et al teach that polyols have 4 to 6 OH groups and partial esters containing not more than 2 (equals one or two) unesterified OH-groups in claims 10 and 12. Thus, a polyol having 4 OH groups and its partial ester having 2 unesterified OH-groups meets the invention. Choosing such partial ester is an anticipation since choice is very limited. See In re Arkley, 455 f2d 586, 172 USPQ 524 (CCPA 1972); In re Petering, 301 F2d 676, 133 USPQ 275 (CCPA 1962). Also, see In re Mills, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples.

The instant invention further recites a polycarbonate selected from the group consisting of copolymers of bisphenol with trimethylcyclohexyl bisphenol over Adelman et al who teach aromatic polycarbonates. However, instant polycarbonate is the art well known commercial product as taught by Harke et al, col. 3, lines 43-53.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the commercial polycarbonate copolymers taught by Harke et al in Adelman et al since aromatic polycarbonates (genus) of Adelman et al encompass the instant polycarbonate copolymers(species) and since such homologs

are expected to behavior in a similar or same manner in Adelman et al with a polyol having 4 OH groups and its partial ester having 2 unesterified OH-groups.

The above rejection is maintained.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The recited preamble, thermoplastic, has little probative value by using of open-ended term, comprising. The instantly recited "comprising" permits the presence of other component such as an acrylic acid monomers, and how to mold a composition is not a limitation of the instant claims. Aromatic polycarbonates (genus) of Adelman et al encompass the instant polycarbonate copolymers(species) and applicant failed to show otherwise.

Claims 1, 3-5, 7, 9, 12, 17-24, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adelman et al (US 4,131,575) in view of Harke et al (US 5,710,204), and further in view of EP 0 511 640.

The instant invention further recites molded articles such as compact discs (CDs) and DVDs over Adelman et al and Harke et al. However, compact discs and DVDs made of a polycarbonate are well known as taught by EP.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to make CDs or DVDs from the composition of Adelman et al and Harke et al with the teaching of EP since compact discs and DVDs made of a polycarbonate are well known in the art.

The above rejection is maintained.

Contrary to applicant's assertion, EP teaches compact discs and DVDs made of a polycarbonate and thus the use of any polycarbonate in making compact discs and DVDs is a *prima facie obviousness*.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/October 28, 2003